

REMARKS

Claims 2, 5-7, 9, 10, 13, 15, 16, 19 and 21-26 are presently pending in this application. By this response no claim amendments have been made, no claims have been canceled and no new claims have been added. However, the Applicants respectfully request the reconsideration of the outstanding rejections over the above-indicated claims for the reasons originally stated in the response filed July 23, 2007, and further clarified by the following additional assertions and remarks.

I. Claim Rejection under 35 U.S.C. § 103(a)

The Examiner has rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,766,494 to Price et al. (hereinafter "Price"), U.S. Patent No. 6,667,876 to Schilit et al. (hereinafter "Schilit '876"), and U.S. Patent No. 5,592,568 to Wilcox (hereinafter "Wilcox") in combination and in further view of U.S. Patent No. 6,279,014 to Schilit et al. (hereinafter "Schilit '014"); and rejects claims 5-7 and 21-25 under 35 U.S.C. § 103(a) as being unpatentable over Price and Schilit '876 and in further view of Wilcox; and rejects claims 9, 10, 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Price and Schilit '876 and in further view of U.S. Patent No. 6,551,357 to Madduri (hereinafter "Madduri"); and rejects claims 13 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Price in view of Schilit '876; and rejects claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Price and Schilit '876 and Wilcox and in further view of Madduri. These rejections are respectfully traversed.

A. Arguments for Patentability of Subject Matter

The Examiner has asserted that the primary arguments raised with respect to claims 13 and 19 fail to be persuasive since the Applicants have allegedly not distinguished the claimed subject matter over the references applied by the Examiner. Those references being specifically the previous combination of Price, Madduri, Wilcox or Schilit '014. Applicants respectfully traverse this assertion.

Applicants respectfully reference the corrections made to claims 7 and 22 within the prior response, specifically as amended, both claims 7 and 22 now recite "an active image of the first content associated with the annotation, wherein the first content changes over time." The threshold issue addressed with this amendment and found throughout the claim amendments

previously made of record in the prior response addresses the *active image of the first content* as recited in claim 7 and moreover an *active content change* as recited within several other amended claims, for example claims 13 and 19. The Examiner is respectfully directed to the specification as originally filed, and respectfully asked to pay particular attention to Figure 12 and the written description appearing on pages 16-17, paragraphs 63 and 64. Particular attention is respectfully directed to the difference between capturing a static image of the content and a separate example of an active content 1202 may be captured and stored locally to allow the content 1204 to be associated with the annotation 1205. See, for example, the Specification as originally filed at the last four lines in paragraph 63.

Understanding the active element of the active content 1202, for example, in this context should provide the Examiner with enough reasonable basis by which to construe the claims in a fashion that clearly distinguish over the prior art made of record.

That said, neither Price, Madduri, Wilcox nor Schilit '014 nor '876, succeed in suggesting or teaching a method or system for receiving data comprising, *inter alia*, the data will include a user interface to allow various selections of an active content change when since the previous access section the active content has changed, and wherein selection of said annotation accesses the at least two documents to display said annotation based on the active content selection, is required by independent claim 13.

B. Application of the Current Rejection to the Claimed Invention

Although the Examiner cites Price in view of Schilit '876 in response to the amended claim limitations, Applicants respectfully assert that both Price and Schilit '876 fail to sufficiently address the active content aspect of the instant claims. In fact, as previously indicated, with Schilit '014 or '876, they both merely discuss a spatial or textual layout, that is an arrangement whereby certain descriptive objects and/or characters may be taken out of context from the document of origin, and may not require any lasting connection, that is a relationship with the document or database from which the information was originally collected. See, for example Schilit '876, column 2, lines 62-65. In fact, it appears that both of the Schilit references are more focused upon the ability to simply remove, that is take out of context certain editorial

notes or graphic embellishments, with these editorial notes or graphic embellishments to be later used for a separate, disconnected reassembly in another document or user interface construct.

Applicants respectfully assert that the above illustration of either Schilit reference is not the focus of their instant claimed invention. In fact, Applicants believe that the Schilit references in combination with the other references merely rise to further evidence of certain shortcomings in the prior art, and appropriately suggest that this combination clearly teaches away from any of the claimed advantages of Applicants invention as set forth in the above claims and accompanying remarks.

With regards to Price, the system discussed by Price merely discusses free-form ink anchors and the generation of links between documents located in different windows. See, for example, Price, abstract.

For at least these reasons, and as previously asserted, Applicants submit that Price fails to anticipate the claimed combination of elements as recited by amended claims 13 and 19. As such, amended independent claims 13 and 19 are clearly patentable over Price. Accordingly, Applicants respectfully assert that the application of Price either alone or in combination with Schilit '876 fails to render the claimed invention obvious for at least the reasons addressed herein.

With regards to Schilit '876, Applicants respectfully assert that Schilit '876 does not provide what is lacking with regards to Price to render Applicants claimed invention, as recited in independent claims 13 and 19, obvious either alone or in combination with Price, for at least the reasons recited above with regards to Price, as well as the additional reasons discussed herein with regards to Schilit '876. Specifically, the Examiner allegedly asserts that Schilit '876 teaches within claim 13, "the data will include a user interface to allow various selections of an active content change when since the previous access session the active content [change when since the previous access session the active content] has changed", and points to column 2, lines 56-65. The brackets are included to remove language that is not present in the pending claim.

Initially, it is not clear what language the Examiner relies upon in claim 13 based on his quoted statement above. It appears that the Examiner has incorrectly understood the claimed limitation since clearly the Examiner has created a contextually ambiguous statement which does

not clearly resemble the language found within claim 13. Applicants respectfully direct the Examiner's attention back to claim 13, and specifically hope that in view of the additional clarifying remarks contained herein, and especially with regards to "active content change" as applied against the references of record, and in view of the highlighted portions of the originally filed specification, will lead the Examiner to a clear conclusion that the claimed invention is patentably distinct for at least the reasons discussed and highlighted herein, as well as for the bases previously discussed within the response filed July 23, 2007.

Insofar as Schilit '876 may be applied generally against the claimed invention, Applicants fail to see how Schilit '876 provides any distinct advantage over the application of Schilit '014. Specifically, and as referenced by the Examiner, Schilit '876, at column 2, lines 56-65 fails to sufficiently discuss any such feature remotely resembling the active content element of Applicants' claimed invention.

Accordingly, with regards to Schilit '876, the cited portion found within column 2, lines 56-65 merely describes a logical relationship between the free-form digital ink annotations and the objects made in one view can be understood in future views based upon the **layout relationships** (emphasis added). Clearly the layout relationships are only an organizational queue which does not have any specific or general application with regards to an active content element as recited above and clearly described within the specification as originally filed. As such, Applicants respectfully assert that the application of Price in view of Schilit '876 under § 103 fails to meet the Examiner's burden of a *prima facie* case of obviousness with regards to at least independent claims 13 and 19. Accordingly, the immediate withdrawal of the prior art rejection of claims 13 and 19 under § 103 to Price in view of Schilit '876 is respectfully requested.

With regards to claims 9, 10, 15 and 16 as being allegedly unpatentable over Price and Schilit '876 in view of Madduri '357 under § 103, Applicants again respectfully assert that the above indicated combination fails to meet the Examiner's *prima facie* basis of obviousness with regards to § 103.

Applicants respectfully assert that for at least the same reasons recited above, Price in view of Schilit '876, and even in view of Madduri fail to render the above recited claims obvious

and for similar reasons recited in the prior response Madduri appears to merely discuss a system for cataloging and marking separate data structures as they are associated with a window appearing within a graphical user interface. As such, Applicants respectfully assert that the Office Action fails to meet its burden under a *prima facie* case of obviousness when attempting to provide what is lacking with the combination of Price and Schilit '876 with the attempted combination with Madduri.

Furthermore, and for at least the reasons discussed above with regards to Price, Schilit '876 and Madduri, the asserted combination fails to render obvious a computer-readable medium having a program stored thereon, comprising *inter alia* associated content will include a user interface to allow various selections of an active content change when since the previous renderable image upon the user interface, the active content associated with the annotation has changed and filtering said combination of said at least two sets based on the active content selection, as required by claim 15. As such, and based on the foregoing, claims 9 and 15 are clearly patentable; because claims 10 and 16 depend from claims 9 and 15, respectively, they are at least patentable by virtue of their dependency as well as for their additional recitations. Accordingly, the immediate withdrawal of the rejection of claims 9, 10, 15 and 16 under § 103 over Price and Schilit '876 in view of Madduri is respectfully requested.

With regards to claims 5-7 and 21-25 being rejected under the combination of Price, Schilit '876 and Wilcox in further view of Schilit '014; it is respectfully asserted that Schilit '876 and Schilit '014 either individually or in combination, fail to provide what is lacking with the combination of Price and Wilcox to render the subject matter of claim 2 obvious. That said, and for the similar reasons asserted with the response of July 23, 2007, both the Schilit '014 and '876 references merely describe a single document or a collection of individual documents all supported by a common word-processing application. Nowhere in either Schilit reference is there any mention of an active content element that even remotely suggests the inventive aspect of at least that element found within Applicants claimed invention. As such, the asserted combination including either or both of the Schilit references, fails to render obvious Applicants claimed invention for at least the reasons discussed above, as such because claim 2 depends from independent claim 23, and for the same reason that Applicants assert that the independent claims,

for example independent claim 23 are clearly patentable over the asserted combination, claim 2 is at least patentable by virtue of its dependency as well as the additional recited limitations supplied by claim 2. Accordingly, the immediate withdrawal of the rejection of claim 2, under § 103 over Price, Schilit '876, Wilcox and in view of Schilit '014 is respectfully requested.

With regards to claims 5-7 and 21-25 being rejected under the combination of Price and Schilit '876 and in further view of Wilcox Applicants respectfully assert that the Examiner has failed to meet his burden of a *prima facie* case of obviousness over claims 5-7 and 21-25. For at least the reasons asserted above with regards to the other independent claims and at least the emphasized elements contained therein, the asserted combination, which appears to be this time focusing upon any distinguishing characteristics found within Schilit '876. Schilit '876 fails to advance the Examiner's burden to render any of the above-indicated claims obvious for at least the reasons discussed herein generally and with specific application to claims 5-7 and 21-25. Accordingly, Applicants request the immediate withdrawal of the rejection of claims 5-7 and 21-25 under § 103 over the asserted combination of Price, Schilit '876, and in further view of Wilcox under § 103.

With regards to claim 26 and the rejection under § 103 as being unpatentable over Price, Schilit '876, and Wilcox, and in further view of Madduri, Applicants respectfully assert that for at least the same reasons discussed above, the Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness. Applicants reassert the same basis with regards to the alleged rejection of claim 26 as applied above with regards to independent claim 23, the claim from which dependent claim 26 depends. As such, claim 26 is clearly patentable because claim 26 depends from a clearly patentably distinct independent claim, claim 23. Accordingly, the immediate withdrawal of the rejection of claim 26 over Price, Schilit '876 and Wilcox, in further view of Madduri under § 103 is respectfully requested.

II. Conclusion

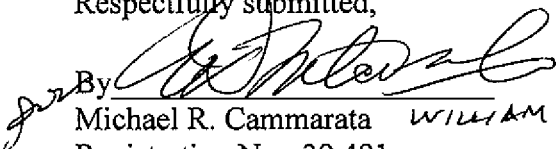
In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application; the Examiner is respectfully requested to contact William D. Titcomb Reg. No. 46,463 at the telephone number of the undersigned below, to conduct a Personal Interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: February 16, 2008

Respectfully submitted,

By  46463
Michael R. Cammarata WILLIAM TITCOMB
Registration No.: 39,491
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant